



APPEAL ROC

SN 09/754,650

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant: | Eric E. Del Sesto et al. | Examiner: | Christopher Lambrecht |
| Serial No.: | 09/754,650 | Group Art Unit: | 2623 |
| Filed: | January 3, 2001 | Docket: | 2050.013US1 |
| Title: | INTERACTIVE CONTENT DELIVERY METHODS AND APPARATUS | | |

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below:

§103 Rejection of the Claims

Claims 1-5, 7-14, 17, 19-22, 24 and 27-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zdepski et al. (U.S. 6,006,256, hereinafter, "Zdepski") in view of Hite et al. (U.S. 6,002,393, hereinafter, "Hite").

The Applicants maintain the arguments presented in the Response of May 1, 2006 remain compelling. The Examiner in the Response to Arguments section of the Final Office Action of August 28, 2006 rebuts as follows:

.... The amendments to the claims fail to patentably distinguish over the prior art of record. Applicant argues on page 11 of the reply that "Zdepski does not discuss replacing interactive content with a second interactive content based on the interactive content code and the option field" and "[a]dding the teachings of Hite doesn't cure the defects of Zdepski." As set forth in the rejections that follow, Zdepski is not relied upon to teach replacing a first interactive content with second interactive content based on the option field of the interactive code. Rather, Hite teaches these features. In particular, Hite discloses replacing first interactive content with second interactive content (i.e., interactive targeted advertisements). Further, Hite teaches that embedded data accompanying said first interactive content instruct an insertion processor to replace the first content with second content based on the value of the embedded instructions (e.g., priority). Accordingly, the examiner submits that the claims are obvious and thus unpatentable over the prior art of record, as detailed in the following rejections. (Emphasis added).

Applicants will now break down and discuss the specific rejection that uses the Hite reference. The Examiner on page 4 of the Final Office Action concedes, “Zdepski fails to disclose that the first video stream comprises first interactive content which is replaced with second interactive content based on the value of an option field included in the interactive content code.” Hereafter, the Applicants will provide the Examiner’s citation of Hite in rejecting the claim limitations and a rebuttal.

Examiner’s citation: “However, in an analogous art, Hite discloses a video stream comprising first interactive content (i.e., an enhanced commercial (col. 3, ll. 60-62))...”

It appears the Examiner has focused on a key word, namely, “enhanced” and has equated it to interactive content. However, a closer inspection of the citation of column 3, lines 60-67 clearly show what is disclosed by Hite is not what is recited in the present claims. The passage indicates that advertising is “enhanced” by, “targeting, delivering and displaying advertising messages (commercials) within specified programming in one or more per-determined households...” (Emphasis added). It is clear Hite discusses merely delivering messages, as stated, and not interactive content. The enhancement described here merely refers to being able to target advertising to specific households. Although Hite discusses a “two-way” reporting mechanism (col. 2, ln. 44-49), this is not interactive content but a reporting mechanism to “track” a user’s viewing habits.

Examiner’s citation: “...supporting interactivity (col. 3, ll. 17-29) which is replaced with second interactive content (col. 4, ll. 29-32)...

The citation at column 3 says Hite includes a “viewer reaction feature” using the upstream reporting feature described at column 2, lines 44-65. This feature, as stated in Hite, can be from a two-way signal transmission or by a toll free telephone number. The point being the user is not interacting with the interactive content but reacting to the content and using a response mechanism separate from the interactive code to register their respective reactions. Everything in Hite indicates that any user reaction/interaction is registered and collected independent of the received commercial message, which is not interactive content.

Examiner’s citation: “...based on the value of an option field (e.g., priority, col. 2, ll. 28-32) included in an interactive content code (instructions transmitted in VBI of television signal, col. 4, ll. 10-21 based on the value of an option field (e.g., priority, col. 2, ll. 28-32) included in an

interactive content code (instructions transmitted in VBI of television signal, col. 4, ll. 10-21), thereby enabling targeted advertising (col. 2, ll. 39-44) and thus more efficient marketing (col. 2, ll. 1-4).

The Examiner has taken the cited portions of Hite out of context with respect to what Hite discloses in regards to signaling and to replacing commercials. Column 4, lines 10-21 discuss how an instruction may be broadcast to a recording device in advance to tell the device which commercial to play and which to ignore at some point in the future. This is clearly not, “the interactive content code and the option field therein, and based on the value of the option field, to produce a control signal to indicate the first interactive content is to be replaced with second interactive content; and ... to insert the second interactive content into the second video stream to produce a third video stream” (Emphasis added). Hite plays a default commercial unless an it is to be replaced by a targeted commercial that is simultaneously broadcast with other commercials (col. 4, ln. 29-35). The display of the targeted commercial is done by having the user’s tuner tune to the frequency containing the targeted commercial (col. 4, ln. 40-49). It is unclear how creating a third video stream including the replaced interactive content is related to Hite’s disclosure of simultaneously receiving a multitude of commercials and selecting one at the user’s receiver to show on the user’s display.

Additionally, there is not a motivation to combine these two references since Hite does not provide the limitations missing from Zdepski and discloses substantially different methodologies to providing content (and not interactive content) to a user. Consequently, even using hindsight reconstruction, one would not combine these references based the stark differences of Hite’s disclosure with respect to Zdepski and the claimed subject matter.

In sum, Zdepski alone or in combination with Hite or any of the other cited references does not disclose every feature of the independent claim 1, and therefore claim 1 and all dependent claims therefrom are patentable over the cited art. The independent claims 8, 14, 17, 19, 20, and 27 include substantially similar subject matter to that of claim 1; therefore all the arguments that apply to claim 1 apply to these independent claims and their respective dependent claims, if any.

Regarding the rejection of claims 6, 15, 18 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Zdepski et al. in view of Hite et al. and further in view of Blackketter et al.

(U.S. 6,415,438, hereinafter, "Blackketter"), please see the arguments presented in the Response of May 1, 2006, page 11, fourth paragraph.

Regarding the rejection of claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Zdepski et al. in view of Hite et al. and Blackketter et al. as applied to claim 15 above, and further in view of Ciciora ("Modern Cable Television Technology"), please see the arguments presented in the Response of May 1, 2006, page 11, fifth paragraph and page 12, first paragraph.

Regarding the rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Zdepski et al. in view of Hite et al. and Blackketter et al. and further in view of Ciciora, please see the arguments presented in the Response of May 1, 2006, page 12, second paragraph.

Regarding the rejection of claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zdepski et al. in view of Hite et al. and Kaiser et al. (U.S. 6,615,408, hereinafter, "Kaiser") and further in view of Ciciora, please see the arguments presented in the Response of May 1, 2006, page 12, fifth paragraph.

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CONCLUSION

Applicants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 408-278-4045 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

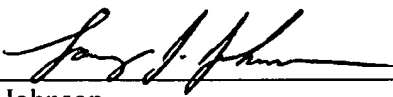
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By their Representatives,

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Date January 29, 2007

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 29 day of 2007.

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